

Appl. No. : 10/628,789
Filed : July 28, 2003

COMMENTS

Claims 1-29 remain pending in the present application, Claims 1, 5, 9, and 10 having been amended, and Claims 15-29 having been withdrawn from consideration. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

In response to the Office Action mailed November 30, 2004, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

All Pending Claims Now Fully Comply With 35 U.S.C. § 112

Claims 5, 9, and 10 stand rejected under 35 U.S.C. § 112, second paragraph, the Examiner maintaining that the language therein is indefinite as filed. In response, Applicants have amended these claims solely to make these claims more easily readable and not to narrow or affect the scope of the claims.

In particular, in response to the rejection of Claim 5 based on the lack of antecedent basis for the phrase “the first surface[s] and the lower surface,” Applicants have amended Claim 5 to recite “extends ~~in~~^{and} a ~~see~~nd lower surface facing a generally opposite direction toward which the ~~firstupper~~ surface faces.” Applicants submit that these changes are hereby made merely to make the claims more easily readable and thus all of the equivalents of the presently recited upper and lower surfaces are also equivalents of the originally recited first and second lower surfaces.

In response to the rejection of Claims 9 and 10 based on the lack of antecedent basis for the phrase “the second surface,” Applicants have amended Claims 9 and 10 to recite “second lower surface.” Applicants submit that these changes are hereby made merely to make the claims more easily readable and thus all of the equivalents of the presently recited second lower surface are also equivalents of the originally recited second surface.

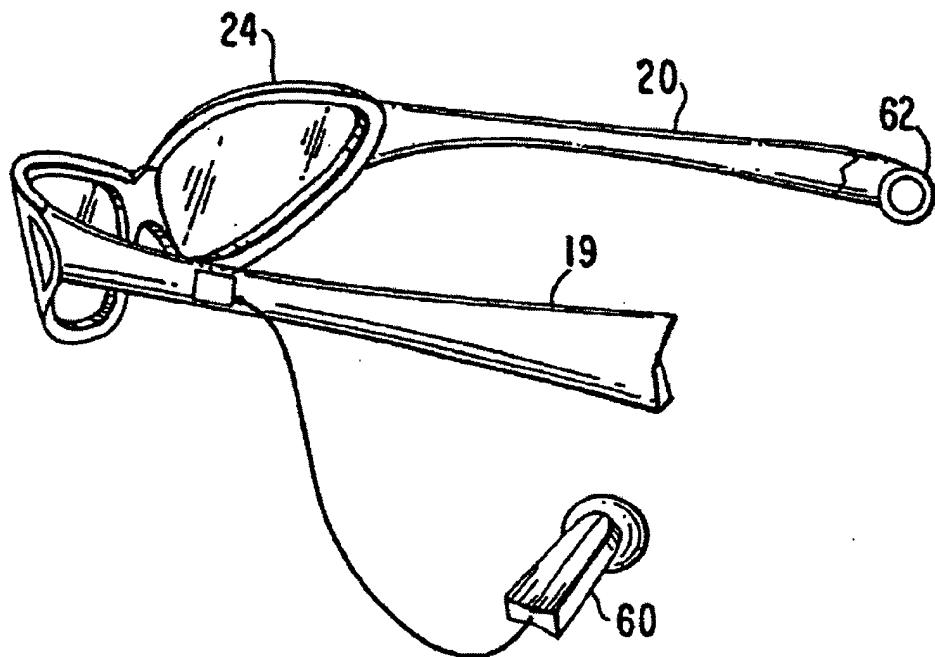
Applicants submit that all pending claims now fully comply with the requirements of 35 U.S.C. § 112.

Swab et al. Does Not Anticipate Claims 1-4, 8, and 11-14

Claims 1-4, 8, and 11-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,769,767 issued to Swab et al. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application,

Applicants have amended Claim 1. Applicants expressly reserve the right to further prosecute the original versions of Claims 1-7 through continuation practice.

Swab et al. teaches eyewear with a transceiver for forming ad hoc networks. Figure 10 of Swab et al. (reproduced below) shows one layout of the Swab et al. eyewear which includes removable earphones 60, 62.



Nothing in the Swab et al. reference teaches eyewear that includes any structure that is configured to allow the speakers to be translated over a predetermined linear path to provide an effective coverage of about 1½ inches and to pivot about axes that are parallel to the linear paths.

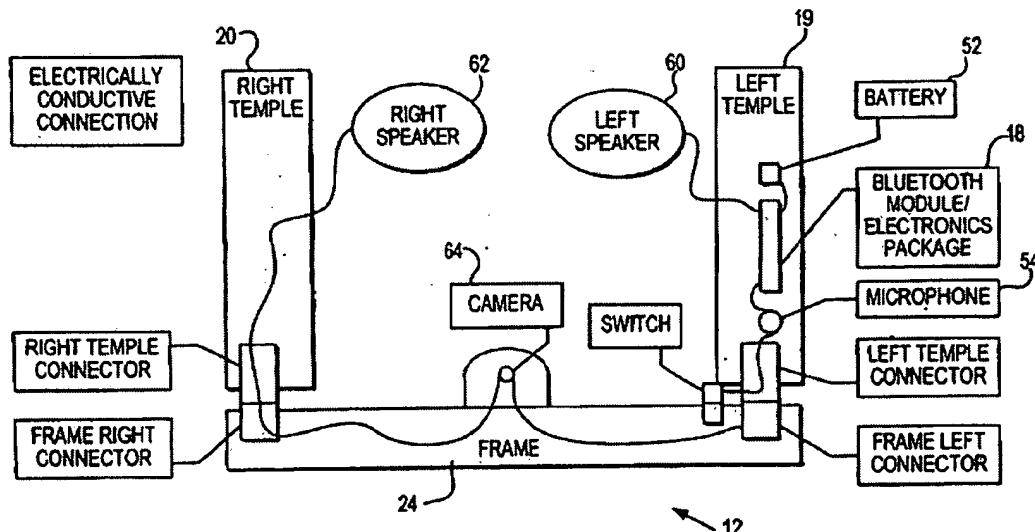
Applicants submit that the Examiner is relying on some combination of the expressly disclosed and inherently disclosed features of Swab et al. to reject Claims 1 and 8. However, it is clear that Swab et al. fails to expressly disclose 1) first and second mounting mechanisms, respectively, configured to allow the first and second ear stems to be translatable along first and second predetermined linear paths in a forward to rearward direction generally parallel to the ear stems, respectively, over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to

provide an effective range of coverage of about at least 1 1/4 inches, and 2) the first and second mounting mechanisms configured to allow the first and second ear stems, respectively, to pivot about first and second predetermined pivot axes that are parallel to the first and second linear paths. Thus, the Examiner's position is that these features are inherently disclosed.

Applicants respectfully submit that it has long been established that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Nothing in the outstanding Office Action indicates what structure in the Swab et al. reference could possibly inherently teach items No. 1 and 2 above. Thus, Applicants submit that the outstanding rejection of Claim 1 cannot be maintained with the Swab et al. reference.

With respect to Claim 8, Applicants submit that the Swab et al. reference fails to teach a compressed audio file storage and playback device in one earstem and a battery in the other. Rather, as shown in Figure 8 of Swab et al. (reproduced below), the Bluetooth electronics package 18 and the battery 52 are in the *same* earstem 19.



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Again, Applicants submit that if the Examiner is relying on an inherent disclosure of Swab et al., Applicant respectfully request that Examiner indicate how that feature is NECESSARILY present in the Swab et al. reference.

In contrast, Claim 8 recites “a compressed audio file storage and playback device disposed in the first ear stem, a power storage device disposed in the second ear stem.”

This distinction is important because, as noted in the present application, by placing the compressed audio file storage and playback device in the first ear stem and the power storage device in the second ear stem, the eyewear is provided with better balance. For example, as disclosed at paragraph [0123] of the present application

[O]ne aspect of at least one of the inventions disclosed herein includes the realization that a desirable balance can be achieved by disposing a power storage device in one ear stem of an eyeglass and play-back device into the second ear stem. Thus, as illustrated in Figures 3J and 3K, the power storage device 274 is disposed in the left ear stem 54' and the storage and play-back device 286 is disposed in the right ear stem 56'.

Nothing the in Swab et al. reference teaches or suggests such an arrangement for achieving light weight and balance. Thus, Applicants submit that Claim 8 clearly and non-obviously defines over the Swab et al. reference.

The Applied Combination of Swab et al./Vogt et al. Does Not Make Obvious Claims 5-7, 9, and 10.

Claims 5-7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being obvious over Swab et al. in view of Vogt et al. Applicants respectfully traverse the present rejection.

As noted above, Applicants submit that Claims 1 and 8 are allowable. Additionally, Applicants submit that Claims 5-7, 9, and 10 are also allowable, not only because they depend from Claims 1 or 8, but also on their own merit.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any

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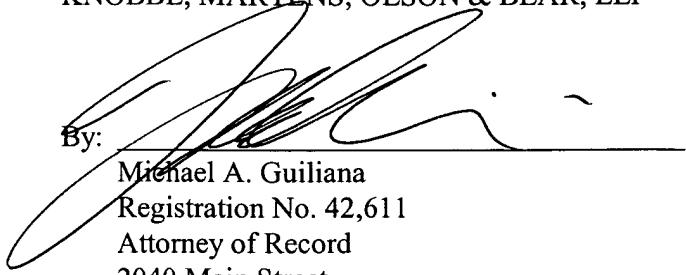
undevloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

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